

REMARKS

I. INTRODUCTION

Claims 1-7, 11, 13, and 35-50 are pending. By this Amendment, claims 1, 11, and 13 are hereby amended to more clearly recite the features of the invention. Claims 5, 6, and 35-37 are amended to correct formal matters. Claims 9, 10, and 15-34 are hereby canceled (claims 8, 12, and 14 were canceled by the amendment originally submitted June 1, 2005). New claims 38-50 are added. In view of the foregoing amendments and following remarks, the Applicant respectfully requests reconsideration of the application and submits that the application is in condition for allowance. A notice indicating the same is respectfully solicited.

II. CLAIM OBJECTIONS

On page 4 of the Final Office Action dated December 30, 2005, claim 10 is objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant respectfully disagrees with the objection and the underlying reasoning. Nevertheless, in the interest of speeding prosecution, claim 10 is hereby canceled, thus rendering the objection moot.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 112

On page 4 of the Final Office Action, claim 9 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully disagrees with the rejection and the underlying reasoning. Nevertheless, in the interest of speeding prosecution, claim 9 is hereby canceled, thus rendering the rejection moot.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

On pages 5-6 of the Final Office Action, claims 1, 2, 4, 5, 7, 9-11, 13 and 35-37 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,473,741 to Baker. The rejection is respectfully traversed. Nevertheless, by this Amendment, independent claims 1, 11, and 13 are amended to more clearly recite the features of the invention. Accordingly, it is

respectfully submitted that Baker fails to anticipate at least claims 1, 11, and 13, as amended. Moreover, claims 9 and 10 are hereby canceled, thus rendering the rejection moot with respect to claims 9 and 10.

Claim 1, for example, recites:

A method for collecting tax information by a tax information requestor comprising the steps of:
 connecting electronically said tax information requestor to an electronic intermediary;
 collecting electronically at least one of an electronic tax return or tax data of a taxpayer from said electronic intermediary, ***wherein said electronic tax return and/or tax data is electronically provided to said electronic intermediary by a tax data provider;*** and
 performing a check of said taxpayer by said tax information requestor using said electronic tax return or tax data collected electronically,
 wherein said check is not used to compute taxes of said taxpayer, wherein said tax information requestor is not a taxing authority, and wherein said electronic intermediary stores said electronic tax return or tax data. (emphasis added).

Thus, claim 1, as amended, requires the step of “collecting electronically at least one of an electronic tax return or tax data of a taxpayer from said electronic intermediary, ***wherein said electronic tax return and/or tax data is electronically provided to said electronic intermediary by a tax data provider.***” Support for the foregoing recitation is provided, for example, at page 18, lines 1-4 of the instant disclosure. *See also* FIG. 3. As set forth in the Background Section of the instant disclosure (for example, page 5, lines 6-8), tax information is usually stored, manually accessed, and manually duplicated by a respective taxpayer who then provides the tax information to a tax information requestor upon request. This, unfortunately, allows the possibility that such tax information may be altered by the taxpayer or inaccurate when provided to the tax information requestor. Therefore, the recitation in claim 1 requiring that a tax data provider electronically provide the tax information (i.e., the electronic tax return and/or the tax data) to the electronic intermediary helps to ensure that the tax information is accurate and unaltered.

Baker, on the other hand, purportedly teaches a method and system for aggregation and exchange of electronic tax information for marketing purposes, wherein the tax information is provided by individual accounting and tax preparation firms and is warehoused at a central location for access by 3rd party requestors. *See e.g.*, column 1, lines 15-19; column 10, line 56 – column 11, line 20. Importantly, the tax information described in the method and system of Baker is provided by *individual accounting and tax preparation firms* to the central location (e.g., a service bureau 20) and, thus, inevitably faces problems similar to the known prior art discussed in the background section of the instant application. That is, the tax information provided to a 3rd party requestor by the centralized service bureau 20 in Baker is susceptible to alteration and inaccuracies because such tax information was originally submitted by the respective taxpayer to the aforementioned individual accounting and tax preparation firms. For example, a taxpayer could, theoretically, inflate his or her salary, or taxable income, and instruct his or her accountant to file a return based thereon. Alternatively, the taxpayer could instruct the accountant to file a tax return and subsequently file an amended return without consulting the accountant. In either case, therefore, the tax information held by the individual accounting and tax preparation firm, and transmitted to the service bureau, may be incorrect. Although Baker notes that “[i]ndividual firm databases are more reliable . . . than IRS or other agency computers” (column 6, lines 16-18) and that “lenders and other interested 3rd parties have *some* assurance that information received directly from a professional tax preparer has not been altered in a fraudulent manner” (column 5, lines 60-63 (emphasis added)), the system and method described in Baker cannot guarantee the quality and accuracy of the information.

As noted above with regard to claim 1 of the instant application, however, the recited tax information does not derive from the taxpayer, but rather from tax data providers which are the very source of the tax information. *See, e.g.*, page 9, line 22 through page 10, line 3 of the instant disclosure. Such tax data providers are generally subject to IRS penalties if they incorrectly report taxpayer tax information. Thus, because the tax information is not originally prepared and/or submitted by the taxpayer but is, instead, prepared and/or submitted by third party tax data providers with independent reasons for assuring the veracity of the tax information, such tax information is inherently more reliable.

Claims 11 and 13 include recitations similar to that of claim 1. In view of the foregoing, it is respectfully submitted that at least claims 1, 11, and 13 are not anticipated by, or rendered obvious in view of, Baker. Claims 2, 4, 5, 7, and 35 depend from claim 1 and are submitted as being allowable over Baker for at least the same reasons. Claim 36 depends from claim 11 and is submitted as being allowable over Baker for at least the same reasons. Claim 37 depends from claim 13 and is submitted as being allowable over Baker for at least the same reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

V. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

On pages 7-9 of the Final Office Action, claims 3 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker in view of Official Notice taken by the Examiner. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. In view of the foregoing guidelines, the rejections are respectfully traversed for at least the following six reasons.

First, claims 3 and 6 depend from amended claim 1 and are, therefore, submitted as being allowable for at least the same reasons presented above. Reconsideration is respectfully requested.

Second, with regard to claim 6, the Applicant respectfully submits that the recited phrase “tax data provider” is not merely non-functional descriptive material which fails to provide a patentable distinction over the prior art. *See* Final Office Action, page 8. As set forth at lines 21-22 on page 9 of the instant disclosure, “[t]he term ‘tax data provider’ refers to each *party* that has tax information relevant to the taxpayer’s tax liability or tax reporting obligations” (emphasis added). Accordingly, the Office Action’s interpretation of an actual entity capable of providing tax information (i.e., the tax data providers) as constituting “descriptive material” demonstrates a

complete misunderstanding of the legal guidelines regarding identifying descriptive material and the interpretation thereof. M.P.E.P. § 2106(IV)(B)(1), for example, states:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of ***data structures and computer programs*** which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to ***music, literary works and a compilation or mere arrangement of data***. (emphasis added).

The foregoing definitions of the types of descriptive material, thus, provide guidance to Examiners in determining whether or not particular **data structures** recited in computer-related claims are statutory subject matter. Furthermore, for purposes of determining compliance with 35 U.S.C. §§ 102 and 103, M.P.E.P. § 2106(VI) states:

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV.B.1(b).

Both of the foregoing determinations are *clearly irrelevant* in terms of interpreting the phrase "tax data providers" which is, within the context of the disclosed embodiments of the present invention, an actual entity or party capable of providing tax information. Accordingly, the Applicant respectfully submits that the Office's interpretation of the term "tax data providers" is without merit.

Third, with respect to claim 6, the Applicant respectfully submits that the Office's interpretation of the individual accounting and tax preparation firms described in Baker as possibly being considered a "taxing authority" (*see* Final Office Action, pages 7-8), is improper. The term "taxing authority" is explicitly defined in the instant disclosure as being "the IRS, or a

state, local, or foreign taxing authority.” *See, e.g.*, page 14, lines 9-10 of the instant disclosure. It is this “taxing authority” with which tax returns are filed by taxpayers. *See, e.g.*, page 14, lines 6-10 of the instant disclosure. Likewise, it is this “taxing authority” to which taxes are owed or from which a tax refund is due. *See, e.g.*, page 14, lines 11-14 of the instant disclosure. Accordingly, the individual accounting and tax preparation firms described in Baker do not meet this definition, and it would not have been obvious to one having ordinary skill in the art to modify the method and system of Baker such that the tax information is provided by “tax data providers” such as, for example, “taxing authorities.” As noted above and in the instant disclosure, the recitation in claim 1 requiring that a tax data provider electronically provide the tax information (i.e., the electronic tax return and/or the tax data) to the electronic intermediary helps to ensure that the tax information is accurate and unaltered and, thus, represents an patentable distinction over the prior art. Thus, the individual accounting and tax preparation firms described in Baker are not “taxing authorities.”

Fourth, with regard to claim 6, the Applicant respectfully submits that the Office’s taking of Official Notice is inadequate. Claim 1 recites “said electronic tax return and/or tax data is ***electronically provided*** to said electronic intermediary ***by a tax data provider***,” and claim 6 provides specific instances of “a tax data provider.” The Office states “that it is old and well-known in the art of tax preparation to utilize tax data received from an employer, a partnership, a bank, a savings and loan institution, a mortgage institution, a credit card bureau, a thrift institution, a securities brokerage firm, a mutual fund holding institution, a charity, the IRS, or a taxing authority to complete one’s tax paperwork (e.g., tax returns)” and that, as a result, “it would have been obvious to one having ordinary skill in the art at the time of Applicant’s invention to modify Baker to receive tax data from [any one of the above-referenced parties].” Final Office Action, page 8. The Applicant respectfully disagrees. Even if it is considered well-known to utilize tax data received from one of these parties to complete one’s own tax returns, the Applicant respectfully submits that it is not well-known in the art for a “tax data provider” (as defined in the instant application) to **electronically provide** an electronic tax return and/or tax data to a tax information requestor via an electronic intermediary or, alternatively, directly to

a tax information requestor. The Official Notice fails to address this recitation. Thus, claim 6 is allowable over Baker and the Official Notice.

Fifth, regarding claim 6, the Office's taking of Official Notice is unsupported by documentary evidence and, thus, does not cure the above-referenced deficiencies of Baker. Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known. M.P.E.P. § 2144.03(A). In this case, the Applicant respectfully submits that the step of electronically providing an electronic tax return and/or tax data to said electronic intermediary *by at least one of the recited tax data providers* is not capable of instant and unquestionable demonstration as being well-known. Should the Office decide to maintain the taking of Official Notice on this point, the Applicant respectfully requests that documentary evidence be provided in support thereof. *See* M.P.E.P. § 2144.03(C).

Sixth, as to claim 6, Baker teaches away from the modification proposed by the Office. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. § 2143.01(VI). At page 9, lines 1-3, the Final Office Action states that it would have been obvious to modify Baker to receive tax data from one of the recited tax data providers, rather than from individual accounting and tax preparation firms, "in order to expand the type of details made available through the data warehouse, thereby increasing the potential of interest in and marketability of the type of data stored in the data warehouse." The Applicant respectfully disagrees and submits that such modification would not have been obvious in view of the teachings of Baker. Baker is clear in teaching that the tax information is only provided by individual accounting and tax preparation firms and that "[t]his represents a *very material difference* from all prior art." Baker, column 2, lines 33-38 (emphasis added). Thus, Baker does not contemplate such tax information being received from any other source such as, for example, the tax data providers recited in at least claim 6. Moreover, based on the foregoing statement, such modification would be contradictory to Baker's core principle of operation. *See* Baker, column 5, lines 34-39. Accordingly, Baker

teaches away from the modification proposed by the Office Action, and the Office has failed to set forth a *prima facie* case of obviousness.

Based on the preceding arguments, the Applicant respectfully submits that at least claims 3 and 6 are not unpatentable over Baker. Reconsideration and withdrawal of the rejections are respectfully requested.

VI. NEW CLAIMS 38-50

By this Amendment, new claims 38-50 are added. Claims 38 and 39 depend from claim 11 and are submitted as being allowable over Baker for at least the same reasons set forth above. Claims 40 and 41 depend from claim 13 and are submitted as being allowable over Baker for at least the same reasons set forth above.

New independent claims 42, 45, and 48 recite a method, apparatus, and computer-readable medium, respectively, and include the step of, or means for, “collecting electronically at least one of an electronic tax return or tax data of a taxpayer from said tax data provider.” Support for the foregoing recitations is provided, for example, at page 18, lines 6-7 of the instant disclosure. *See also* FIG. 3. For substantially the same reasons outlined above with regard to Baker, it is respectfully submitted that at least claims 42, 45, and 48 are allowable. Claims 43-44, 46-47, and 49-50 depend from claims 42, 45, and 48, respectively, and are, therefore, submitted as being allowable for at least the same reasons. Prompt consideration of these claims on the merits is respectfully requested.

VII. CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

It is not believed that extensions of time or other fees are required beyond those that may otherwise be provided for in documents accompanying this paper. If, however, additional

extensions of time are needed to prevent abandonment of this application, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims or any other fee deficiency), are hereby authorized to be charged, and any overpayments credited to, our Deposit Account No. 22-0261.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Dated: June 29, 2006

Respectfully submitted,

By 
Michael A. Sartori, Ph.D.

Registration No.: 41,289

Ryan M. Flandro

Registration No.: 58,094

VENABLE LLP

P.O. Box 34385

Washington, DC 20043-9998

(202) 344-4000

(202) 344-8300 (Fax)

Attorney/Agent For Applicant

DC2/760733